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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/20/2003

Jerry Loren McLaughlin

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

09/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/717,746	Applicant(s) MCLAUGHLIN ET AL.	
	Examiner D. L. Jones	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,9 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 7, 9, and 15024 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 5/17/07 wherein claims

1-6, 8, and 10-14 were canceled and claims 7, 9, 15-18, and 20 were amended; and claims 21-24 were added.

Note: Claims 7, 9, and 15-24 are pending.

RESTRICTION INTO GROUPS

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 7, 9, and 15-24, drawn to method of preparing a crude extract containing one or more acetogenin compounds from the species *Asimona*, classified in class 424, subclass 725+.
- II. Claims 7, 9, and 15-24, drawn to a method of preparing a crude extract containing one or more acetogenin compounds from the species *Annona*, classified in class 424, subclass 725+.
- III. Claims 7, 9, and 15-24, drawn to a method of preparing a crude extract containing one or more acetogenin compounds from the species *Goniothalamus*, classified in class 424, subclass 725+.
- IV. Claims 7, 9, and 15-24, drawn to a method of preparing a crude extract containing one or more acetogenin compounds from the species *Uvaria*, classified in class 424, subclass 725+.

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- V. Claims 7, 9, and 15-24, drawn to a method of preparing a crude extract containing one or more acetogenin compounds from the species Disepalum, classified in class 424, subclass 725+.
- VI. Claims 7, 9, and 15-24, drawn to a method of preparing a crude extract containing one or more acetogenin compounds from the species Xylopia, classified in class 424, subclass 725+.
- VII. Claims 7, 9, and 15-24, drawn to a method of preparing a crude extract containing one or more acetogenin compounds from the species Rollina, classified in class 424, subclass 725+.

Note: Claims appearing in more than one group will only be examined to the extent that they read on the elected invention.

3. The inventions are distinct, each from the other because of the following reasons: Inventions I-VII are directed to related methods of preparing a crude extract containing one or more acetogenin compounds from different species (Asimona, Annona, Goniiothalamus, Uvaria, Disepalum, Xylopia, and Rollina). The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are distinct from one another because the scopes do not overlap (distinct species), the acetogenin compounds associated with each species is not

necessarily an obvious variant of another species, and the inventions have a different mode of operation. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants. In particular, it is noted that on page 1, paragraph [0006], of the instant application that it is disclosed that the major active compounds in the Annonaceae family are called acetogenins which are long chain fatty acid derivatives that terminate in an alpha, beta-unsaturated gamma lactone ring. The acetogenins typically contain from zero to three tetrahydrofuran rings in the chain. The active acetogenin in the paw paw tree (*Asimina triloba* Dunal, Annonaceae) is more than 50. Related tropical and subtropical species in the Annonaceae family (species in the annonaceous genera *Annona*, *Asimina*, *Goniothalamus*, *Rollinia*, *Uvaria*, and *Xylopia*) have yielded an additional 350 compounds. Thus, there are more than 400 acetogenin compounds associated with the Annonaceae family that vary from specie to specie.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

ELECTION OF SPECIES

5. Claims 7, 9, and 15-24 are generic to the following disclosed patentably distinct species of the Annonaceae family. The species are independent or distinct because the

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Annonaceae family involves several tropical and subtropical species such as Annona, Asimina, Goniiothalamus Rollinia, Uvaria, Xylophia, and Disepalum. The Annonaceae family contains over 400 acetogenin compounds. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Note: *The Examiner respectfully requests that the Applicant elect a single disclosed species from within the elected group above. In particular, Applicant is respectfully requested to identify the acetogenin compound(s).*

6. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

7. Due to the complexity of the restriction requirement, a telephone call was made not made to request an oral election to the above restriction requirement.

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8. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

9. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

10. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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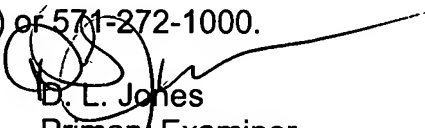
COMMENTS/NOTES

12. The above election of species is deemed necessary because of the amending of the claims and the multitude of acetogenins encompassed by the various species (Annona, Asimina, Goniiothalamus, Rollinia, Uvaria, Xylopia, and Diseparlum).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


D. L. Jones
Primary Examiner
Art Unit 1618

September 3, 2007